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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,189	09/27/2004	Masahiro Arioka	Q83676	5191

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EXAMINER

VORTMAN, ANATOLY

ART UNIT PAPER NUMBER

2835

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/509,189

Applicant(s)

ARIOKA, MASAHIRO

Examiner

Anatoly Vortman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/27/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Information Disclosure Statement*

1. Information Disclosure Statement filed on 09/27/04 lacks copies of the foreign and non patent literature references. Only copies of JP/11-185577 and JP/06-311614 are on file, therefore only JP/11-185577 and JP/06-311614 have been considered.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-14, the claims replete with the open-ended clauses, thus rendering the scope of the claims indefinite. **For example**, claim 1 recites: “frame capable of supporting”, which does not define a structure, but merely a possibility that something may be supported by said frame. Likewise, claim 2 recites: “the cable connecting bushing can be mounted” Again, no definitive structure is recited, but only the possibility. Again, the aforementioned recitations are **only the examples**. The remaining claims are replete with “can be made” and “can be mounted” clauses. Language that suggests or makes optional but does not limit a claim to a particular

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structure does not limit the scope of a claim or claim limitation. (MPEP 2106[R-3] II (C) and MPEP 2111.04 [R-3]). Therefore, during the art rejection of the claims, all of the features associated with said clauses will not be given patentable weight, since the presence of said features in the device structure is optional.

Furthermore, claims 2, 6-8, 10, and 11-14, are replete with antecedent problems. Claims recite limitations: “the bus bar bushing” and “the cable connecting bushing”, which lack antecedent basis, since said “bushings” had never been positively set forth in the parent claim 1.

Applicant is hereby required to carefully review all pending claims in order to correct the aforementioned and similar not mentioned above deficiencies.

#### ***Claim Objections***

4. Claims 10-14, recite the limitations: “a module” and “a grounding switch or a disconnecter” in the last several lines of the claims. These limitations have been positively set forth in the parent claim 1, and therefore, should be recited with article “the” instead of “a”.

Applicant is hereby required to carefully review all pending claims in order to correct the aforementioned and similar not mentioned above deficiencies.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by EP/0,924,827 to Quenin et al. (Quenin).

Regarding claims 1 and 2, as best understood, Quenin disclosed (Fig. 7) a gas-insulated switchgear in which main circuit equipments are accommodated within a tank (54) hermetically filled with an electrically insulating gas, comprising; at least one switchgear module in which a disconnecter (18) with a grounding switch (24) and an electrically insulating frame ((56, 58) and not-numbered member supporting a vacuum valve (14)) capable of supporting an interrupter (27, 14) including a vacuum valve (14) are disposed in the tank (54) in a vertically stacked relationship, and in which said disconnecter (18) and said vacuum valve (14) are connected between their movable rods (26, 30) (see also translated abstract, lines 7-10).

Regarding claims 3 and 4, as best understood, Quenin disclosed (Fig. 7) a plurality of the switchgear modules (the upper module accommodating the disconnecter, switches and the vacuum valve, and the bottom module accommodating components (20, 50, 48)) are connected to each other via a spacer (56, 58) hermetically connecting said tank (54) to define a circuit.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9 and 10, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Quenin in view of US/6,515,247 to Tsuzura et al., (Tsuzura).

Regarding claims 9 and 10, as best understood, Quenin disclosed all, but the lightning arrester.

Tsuzura disclosed a gas insulated switchgear (Fig. 1) having a lightning arrester (32) to provide protection from the lightning-induced overvoltages.

It would have been obvious to a person of ordinary skill in the switchgear art at the time of the invention to provide switchgear of Quenin with a lightning arrester as taught by Tsuzura in order to provide protection from the lightning-induced overvoltages.

9. Regarding claims 5-8 and 11-14, the claims have not been rejected on the art of record because each of the claims recites: "said tank is provided, at the front face thereof, with an opening portion that is hermetically closed by a mounting plate [...] and, at the rear face thereof, with an opening portion for mounting therein the bus bar bushing and the cable connecting bushing". The aforementioned features are not taught by the references of record, either taken alone or in combination.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

JP/ 2000228806, JP/ 08335430, US/5898565, 6219225, 4967307, 4837662, 4821141, and 4744002 disclosed various gas insulated switchgears.

Please note, that from the aforementioned references, at least the JP/ 2000228806 and JP/ 08335430 could have been also sufficient for rejection under 35 USC 102/103 of at least claim 1 of the instant application.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 571-272-2047. The examiner can normally be reached on Monday-Friday, between 10:00 am and 6:30 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Lynn Feild can be reached on 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

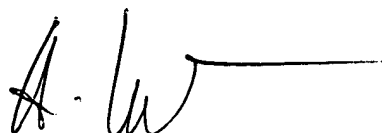
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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AV

A handwritten signature in black ink, appearing to read 'A. Vortman', followed by a horizontal line.

Anatoly Vortman  
Primary Examiner  
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